

REMARKS/ARGUMENT

Claims 1–10 are pending this application. Applicant acknowledges the allowance of claims 3 and 4. In light of the remarks set forth below, Applicant respectfully submits that each of the pending claims is an immediate condition for allowance.

Claims 1, 2 and 5 stand rejected under 25 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,262,637 (“Bradley”) in view of U.S. Patent No. 6,356,746 (“Katayama”) and U.S. Patent No. 6,178,162 (“Dal Farra”). Applicant respectfully requests reconsideration or withdrawal of this rejection.

A reference can only be used for what it clearly discloses or suggests. See In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicant. To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See MPEP § 706.02(j).

Among the limitations of the independent claims, not present in the cited references is “said filter means having a first attenuation more than a predetermined amount and a second attenuation amount not more than a predetermined amount selectively set in a range higher than a transmission signal band.”

The Examiner asserts that the first attenuation amount is shown by Bradley in Fig. 2 reproduced below, as reference designator 36, and a second attenuation amount is disclosed in Bradley at column 1, lines 18-19, and column 4, lines 20-25. At the outset Applicants note that lines 18-19 discuss a duplexer which provides the necessary coupling while preventing the modulated signal generated by the transmitter from being coupled from the antenna back to the receiver or overloading the receiver. Likewise the citation at column 4 refers to Fig. 2.

As previously discussed by the Applicant, Fig. 2 discloses a transmit band and a receive band. These two distinct bands, as properly noted by the Examiner, are the band pass filters 30 and 32 shown in Fig. 1. Band pass filter 30 is active in the transmit band, while band pass filter 32 is active in the receive band. Thus, these two distinct filters are not the first and second attenuation amount disclosed in a single filter means by the Applicant. The Examiner apparently fails to give patentable weight to the fact that the filter means must contain a first and a second attenuation amount.

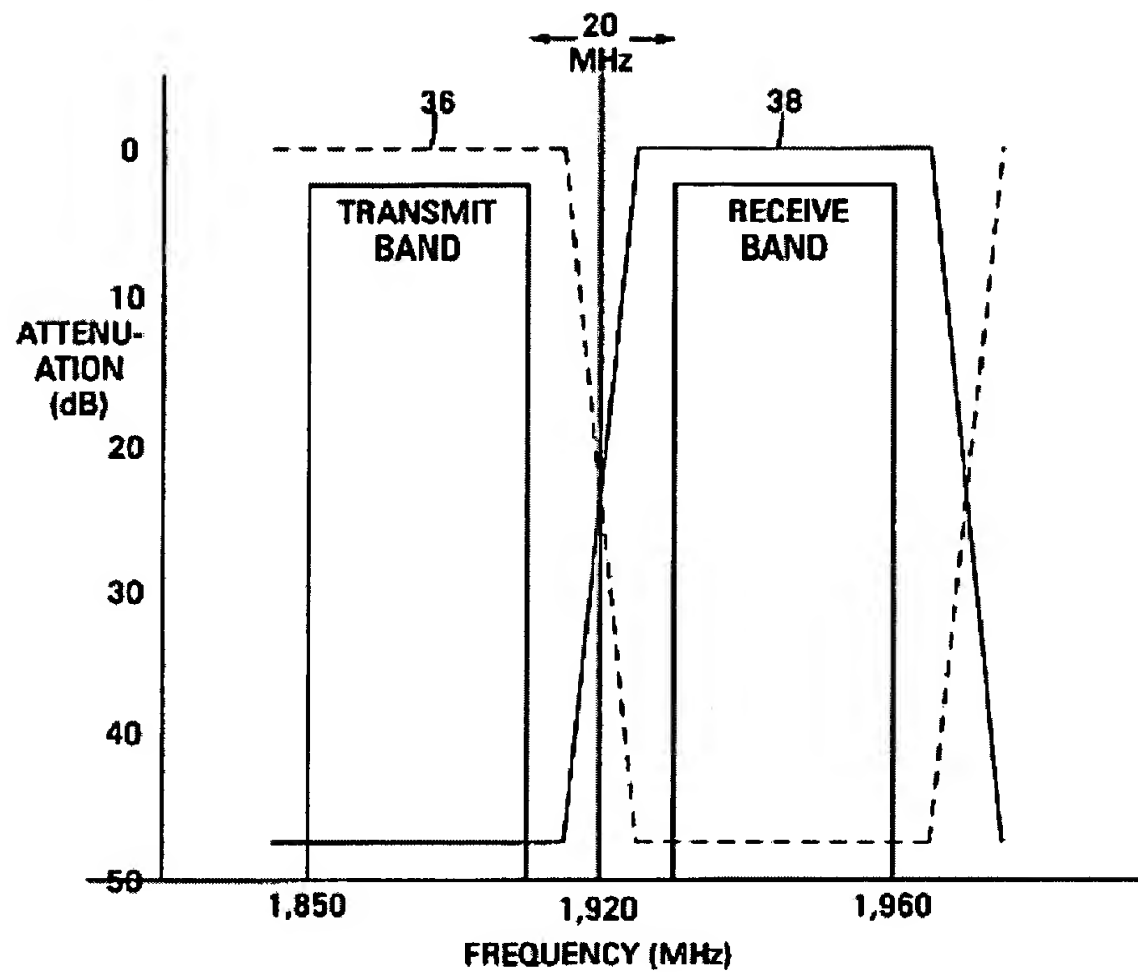
**FIG.2**

Fig. 2 in Bradley cannot be viewed in isolation from the circuit disclosed in Fig. 1, reproduced below. The first pass band represented by the dashed line 36 is the responsive filter 30 in the transmit path. The second pass band represented by the solid line 38 is the responsive filter 32 in the receive path. Thus, there is no single filter in the transmit path having first and second attenuation amounts disclosed by Bradley. Thus, Bradley fails entirely to disclose the adjustable filter means explicitly recited in Applicant's claim.

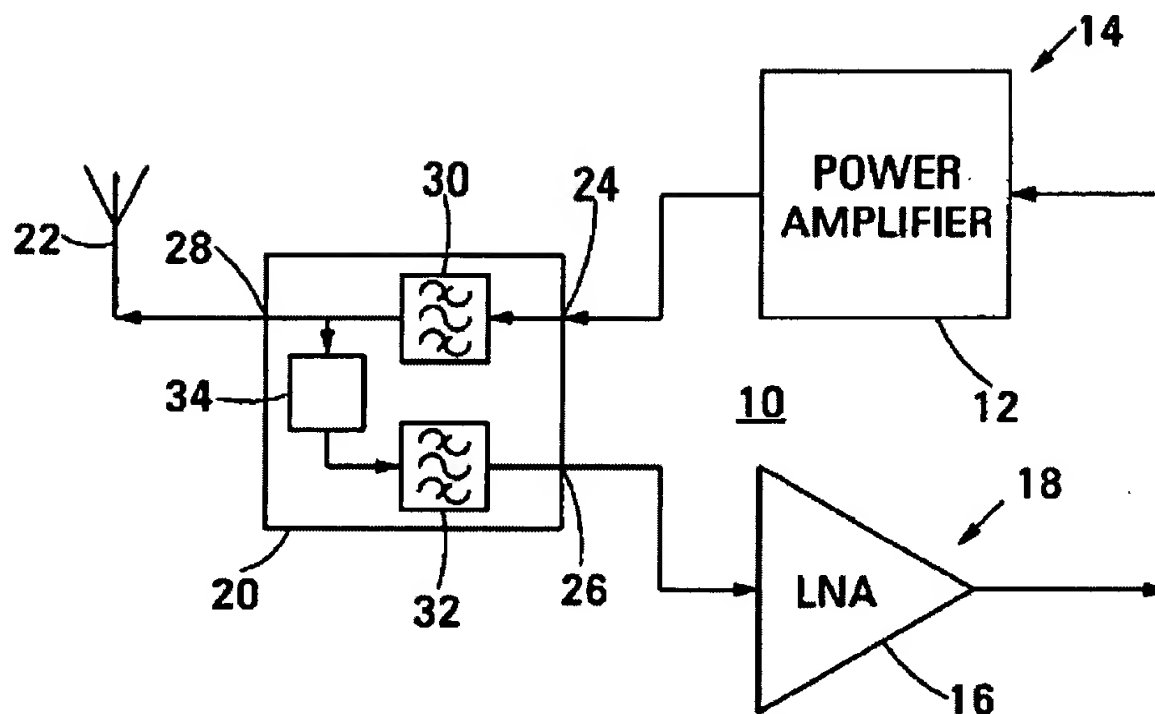


FIG. 1

The Examiner goes on to include Katayama, because Katayama teaches adjustable filters. The Examiner states that:

it would have been obvious, to one of ordinary skill and art, at the time the invention was made, to arrive at the adjustable filter as recited by the instant claims, because the combined teaching of Bradley with Katayama suggests an adjustable filter as recited by the instant claims. Furthermore, one of ordinary skill and art, would have been motivated to combine the teachings of Bradley with Katayama, because Bradley suggests configuring a filter (something broad) in general, and Katayama suggests the beneficial use of adjusting or configuring the filter periodically (such as having a feedback system to have better quality system) in the analogous art of filters.

See Office Action at 3 (emphasis added).

First, Applicant respectfully submits that the Examiner's first recited motivation in combining Bradley and Katayama is nothing more than hindsight reconstruction using Applicant's claim as a template and for finding various pieces of

art which individually meet the limitations of the claim. This is patently incorrect to do. There must be some motivation in the references themselves to motivate one to combine the right teaching and the various references.

Additionally, the Examiner's second motivation to combine Bradley with Katayama fails because Bradley does not teach "configuring a filter." Bradley's "configuring " is merely designing the filters so that there is a specified overlap. In Bradley only one filter is used in the transmission path. Thus, there would be no reason to investigate multiple filters in a given path.

The Examiner then includes Dal Farra as teaching selecting during operation, between first and second attenuation amount. Again, the Examiner notes that "it would have been obvious, to avoid one of ordinary skill in the art at the time the invention was made, to arrive at the selecting, during operation, between first and second attenuation as recited in the instant claims because the combined teachings of Bradley with Dal Farra, suggests suggesting, during operation, between first and second attenuation as recited by the instant claims."

Again, hindsight reconstruction should not be used in rejecting Applicant's claims. The Examiner's second motivation for combining these two efforts fails. As discussed above, because Bradley does not suggest anything other than the single band pass filter in the transmission path there is no reason to investigate selecting between various filters.

Applicant respectfully submits that just because the Bradley reference disclosed two filters it does not mean that those two filters are related. Specifically, Applicant recites a single adjustable filter, for reducing leakage power that has a first

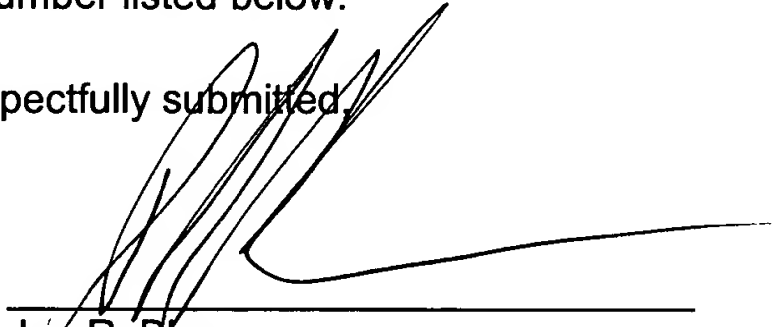
attenuation amount and second attenuation amount. Those first and second attenuation amounts can be selected during operation. None of these features are present in the three references cited by cited by the Examiner either individually or in combination. Therefore the Examiner's rejection should be withdrawn.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

Dated: September 13, 2005

Respectfully submitted,

By:



Ian R. Blum
Registration No.: 42,336
DICKSTEIN SHAPIRO MORIN
& OSHINSKY LLP
1177 Avenue of the Americas
New York, New York 10036-2714
(212) 835-1400
Attorney for Applicant